

REMARKS

The present application includes pending claims 1-7, 9-18, 20-34 and 36-61, all of which were rejected. In particular, claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, and 60-61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,799,201 (“Lee”) in view of U.S. 2004/0073932 (“Lavelle”). Claims 41, 47, and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Lavelle and U.S. 2004/0203379 (“Witkowski”). Claims 25-30, 52, and 54-55 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Lavelle and U.S. 2003/0097655 (“Novak”). The Applicants respectfully traverse these rejections for at least reasons previously discussed during prosecution and the following:

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Moreover, “[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03 (emphasis added). Further, “[**all**] words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.* (emphasis added).

As the Federal Circuit recently noted, “[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that ... claims are obvious.” See *In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

“[W]hile *KSR* relaxed some of the formalism of earlier decisions requiring a ‘teaching, suggestion, or motivation’ to combine prior art references, it did not remove the need to anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references.” See *id.* at page 17. Moreover,

KSR did not free the PTO’s examination process from explaining its reasoning. In making an obviousness rejection, the examiner **should not rely on conclusory statements** that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, **the examiner cites prior art references to demonstrate the state of knowledge.**

Id. (emphasis added).

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some **concrete evidence in the record** in support of these findings.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

With those principles in mind, the Applicants now turn to the claims, in particular.

I. Independent Claims 1, 14, 25, And 31

Claim 1 recites, in part, “**set top box circuitry** communicatively coupled to the storage, ... the set top box circuitry **being remotely located from the authorized vehicle**; at least one vehicle system within the authorized vehicle **remotely located from and communicatively coupled to the set top box circuitry** via the second communication interface, ...a user interface to support the delivery of media, the user interface having at least one view comprising a representation of a sequence of media available for delivery to the at least one vehicle system, the at least one view comprising a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

Thus, the claim is clear that the system includes **set top box circuitry** that is **remotely located from the vehicle (that is, not within the vehicle)**, and a video game is transferred from the set top box circuitry to the entertainment system within the vehicle system or a handheld game through the set top box circuitry. Independent claims 14, 25 and 31 recite similar limitations.

The Office Action asserts that Lee discloses all the limitations of claim 1, except for “transfer of a video game to one or both of the entertainment system and/or a handheld electronic game system via the at least one vehicle system.” *See* March 15, 2010 Office Action at page 6.

As a side note, the Office Action therefore seems to acknowledge that Lee cannot describe, teach or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

A. Set Top Box Circuitry Remote From A Vehicle

The Applicants respectfully submit, however, that Lee also does not describe, teach or suggest “set top box circuitry,” as recited in claim 1. Instead, Lee discloses a system that “consists of (1) a remotely programmable, microcomputer controlled multimedia device 20 in a vehicle with a wireless IP address for Internet access, (2) an Internet gateway network 30 that provides programming, information and Internet access to the multimedia device 20, and (3) one or more remote programming devices 40.” *See* Lee at column 6, lines 8-14 (emphasis added). “Consists of” is a **close-ended** phrase. *See, for example*, MPEP at 2111.03

The Applicants note that reference numeral 30, which the Office Action relies on as “set top box circuitry” (*see* March 15, 2010 Office Action at pages 2-3) is an “Internet gateway network” (*see* Lee at column 6, line 11), but **not set top box circuitry**. Instead, the “gateway 30 serves as an Internet Service Provider to vehicles 184 through various forms of wireless transmission 186.” *See id.* at column 11, lines 11-13.

As the Applicants previously explained, **through evidentiary support**, a television set-top box is different than, and includes functionality not found in, the internet gateway network of Lee. Indeed, the Microsoft Press Computer Dictionary, 3rd Edition, at page 431 (previously provided), indicates that a “set-top box” is a “device that converts a cable TV signal to an input signal to the TV set.”

There is nothing in Lee that describes, teaches, or suggests that the “Internet Gateway 30” connects to a television. Lee also does not describe, teach or suggest that the “Internet Gateway 30” connects to a “cable TV network,” or processes “cable TV signals.” Again, the Internet Gateway 30 of Lee is by no means a set-top box, as recited in the claims of the present application.

Notably, the Office Action does not respond to the definition of a set-top box provided by the Applicants. Instead, the Office Action simply provides a series of conclusory statements that the Internet Gateway 30 of Lee is somehow set-top box circuitry. *See* March 15, 2010 Office Action at pages 23-24. Thus, in response to the Applicants providing actual evidence as to the nature of a set-top box, the Office Action does not respond to the definition, but, instead, provides a series of conclusory statements that attempt to equate a “Firewall through Internet (a communication Network)” as a set-top box remotely located from an authorized vehicle. *See id.*

As noted above, however, such an examination process clearly runs afoul of Federal Circuit case law.

KSR did not free the PTO’s examination process from explaining its reasoning. In making an obviousness rejection, the examiner **should not rely on conclusory statements** that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, **the examiner cites prior art references to demonstrate the state of knowledge.**

See In re Vaidyanathan, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

The Applicants respectfully submit that Federal Circuit case law, as well as the MPEP, prohibits the Examiner from making conclusions based on subjective understandings or

experience, as the Examiner is attempting to do with respect to the limitations noted above. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

As explained above, Lee does not describe, teach or suggest a “set top box circuitry” remote from a vehicle and a vehicle system, in particular, or “set top box circuitry,” in general. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 1, 14, 25, 31 and the claims that depend therefrom.

B. Personal Channel Operative To Download A Video Game

Additionally, as noted above, Lee does not describe, teach or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

Lee does not describe, teach or suggest a “**personal channel**” that is operative to download a “**video game.**” In fact, Lee makes only one reference to “game,” and that is in connection with an “interactive **audio** game.” *See* Lee at column 7, line 24 (emphasis added). Lee notes this as a “new personal information service” on the “multimedia device 20.” An “interactive **audio** game” that is a “personal information service” is not the same as a “video game.”

Lavelle discloses a “multimedia entertainment unit for use in a vehicle.” *See* Lavelle at [0001]. The unit may include a “video game player 126.” *See id.* at [0035]. The video game player may be part of, or input into, the entertainment unit. *See id.* at [0046]-[0047]. However,

similar to the Lee, Lavelle does not describe, teach or suggest that video games are downloaded to the entertainment through an external source. Instead, Lavelle simply discloses that a video game player may be directly input to the entertainment unit, and games included on the player may then be played through the entertainment unit (*e.g.*, merely plugging a handheld game into the entertainment unit).

Lavelle at [0035] merely discloses a “display device 112” and a “video game player 126.” **Lavelle makes no mention of transferring games from outside the vehicle** to the “entertainment unit 100.” Lee also does not describe, teach, or suggest transferring video games from a remote source to a vehicle.

Neither Lee, nor Lavelle, describes, teaches, or suggests that video games are downloaded to the entertainment through an external source. Consequently, the combination of the two references cannot describe, teach, or suggest such a feature. Therefore, the proposed combination of Lee and Lavelle does not describe, teach, or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry [which is remote from the vehicle]**, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.”

Thus, for at least these reasons, the proposed combination of Lee and Lavelle (and any other cited reference) does not render claim 1, 14, 25, 31 and the claims that depend therefrom unpatentable.

II. Dependent Claims 40, 46, 52, And 58

Claim 40 recites, in part, “wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system.” Claims 46, 52 and 58 recite similar

limitations. The Office Action relies on Lee as disclosing these limitations. *See* March 15, 2010 Office Action at pages 11-13. As explained below, however, the Office Action is mistaken.

Lee discloses a “GPS receiver 110 that continuously reports the vehicles longitude, latitude and altitude.” *See* Lee at column 8, lines 60-61. “The vehicle 184 provides location information from its GPS receiver 110 (FIG. 2) to the gateway 30, and the gateway 30 in turn provides mapping services to the vehicle showing travel routes or locations of interest.” *See id.* at column 12, lines 14-20.

While Lee discloses location information from the GPS receiver and the gateway 30 providing mapping services, Lee does not describe, teach or suggest “a second **personal media channel** that facilitates **a user-defined navigation update** to the navigation system.” Lee simply does not describe, teach or suggest a user defining a navigation update, in general, or one through another personal media channel, in particular. Lee does describe a user “manually request[ing] from the multimedia device 20 a recalibration of **local audio stations**” (*see id.* at column 15, lines 21-26), but requesting recalibration of local audio stations is by no means a request by the user for a navigation update. Instead, the recalibration is merely directed to local radio stations for listening pleasure. Thus, for at least this reason, the Applicants respectfully request reconsideration of the rejection of claims 40, 46, 52 and 58.

III. Conclusion

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right,

however, to challenge such statements in the future should the need arise (*e.g.*, if such statement should become relevant by appearing in future rejection).

The Applicants respectfully submit that the claims should be allowable for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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